

### Remarks

Claims 41 – 43 are pending.

The amendments to claims 41 and 43 do not include new matter and it is submitted that no additional search would be required to consider these limitations.

Amendments presenting rejected claims in better form for consideration on appeal may be admitted after a final rejection. 37 C.F.R. §1.116 (b).

### **1. Claim Rejections 35 U.S.C. §103**

Claims 41 – 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bryan in view of Clear.

It is submitted that Bryan and Clear combined fail to disclose, teach or suggest an apparatus according to claims 41 – 43.

The combination of Bryan and Clear even if proper, would fail to yield the following aspects of an assembly of the present invention:

- \*placing a row of panels across the series of joists,

- \* providing an elongated spline which spans across more than 2 joists,

- \*inserting the spline into a groove of each panel of the row of panels,

and

- \*securing the row of panels to the deck frame by fastening the spine element to the series of joists.

Bryan '554 does not teach or disclose placing a row of panels across the series of joists, inserting an elongated spline into a groove of each of the panels of the row, and connecting the row of panels to the deck frame by securing the spline to the series of joists. Bryan '554 purportedly only teaches a step of securing an adjacent pair of panels 12' to cross members 26".

Bryan '554 does not disclose or suggest the step of attaching a spline directly to a joist. Rather, spline 18' of Bryan '554 is secured to an intermediate cross member 26". A deck structure according to Bryan '554 would require an additional step of installing and securing cross members 26" between the joists 22. Spline 18' would inherently be sized to span only between a pair of joists 22 as the splines are aligned with cross members 26". Splines 18' of any greater length would interfere with the upstanding portions of joists 22.

There is not teaching or suggestion to lengthen the splines 18' to the presently claimed size as such a modification would render the prior art invention unsatisfactory for its intended purpose, i.e. a deck structure with recessed modular panels supported between upstanding portions of joists 22. *See*, M.P.E.P §2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Furthermore, any proposed modification of Bryan '554 to increase the length of spline 18' so that it spans across and is supported by more than 2 joists would not be obvious as such a modification would change the principle of operation of the prior art invention being modified. *See*, M.P.E.P §2143.01, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

No other combination of references discloses or suggests the use of an elongated spline to secure a row of panels to a deck frame.

## 2. Request for Reconsideration and Allowance

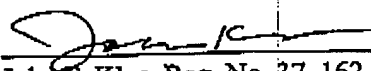
Based upon the above Amendments and Remarks, claim 41 is believed to be in proper form for allowance. Applicant respectfully requests reconsideration of those claims and a prompt Notice of Allowance thereon.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached pages are captioned "Version with markings to show changes made."

Please direct any questions or comments regarding this application to John F. Klos at  
(612) 321-2806.

Respectfully submitted,  
John Potter, by his attorneys,

Date: April 4, 2003



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE (4/4/03)**

In the claims:

Cancel claims 1-11 and 24-28.

41. (amended) A method of building a deck structure comprising the steps of:

providing a deck frame including a series of joists;

providing a plurality of modular panels, each panel being of a layered construction including a top element and a bottom element, said top element being of a material providing substantial compressive strength and limited tensile strength, said bottom element being of a fiber-reinforced material, each panel having at least one groove;

providing [a] an elongated spline element having a length substantially greater than a distance between an adjacent pair of joists, whereby the spline element spans across more than two joists of the deck frame;

placing a row of panels across the series of [panel atop at least two] joists of the deck frame;

inserting the spline element into a groove of [the] each panel of the row of panels; and

securing the spline element to [one or more] the series of joists to connect [the] each panel to the deck frame.

43. (amended) A method of building a deck structure comprising the steps of:

providing a deck frame including a series of joists;

providing a plurality of modular panels, each panel being of a layered construction including a top element and a bottom element, said top element being of a material providing

substantial compressive strength and limited tensile strength, said bottom element being of a fiber-reinforced material, each panel having at least one groove;

providing a plurality of panel support elements;

attaching [a pair of panel] the plurality of panel support elements to [a pair] the series of joists;

providing a spline element;

placing a series of panels [panel] upon the [pair] plurality of panel support elements;

inserting the spline element into a groove of each of the [panel] panels; and

securing the spline element to [one or more] the series of joists to connect the [panel] plurality of panels to the deck frame.